3-10-04 Image

AR 1616

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

IN RE:	BRENNAN, TIMOTHY J.	)	
SERIAL NO:	10/033,632	)	
FOR:	DRUGS FOR SPINAL ANESTHESIA	)	APPEAL NO. _____
FILED:	December 26, 2001	)	**REPLY BRIEF**
GROUP:	1616	)	
EXAMINER:	GEORGE, Konata M.	)	
DOCKET NO:	P05435US0	)	

To the Commissioner of Patents and Trademarks
Mail Stop Appeal Brief - Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Dear Sirs:

Appellants respectfully request that the following Reply Brief be entered into the record pursuant to 37 C.F.R. § 1.193(b)(1).

I. Introduction

This Supplemental Reply Brief is herein filed to address comments and arguments filed in the February 12, 2004 Examiner's Answer.

CERTIFICATE OF MAILING BY EXPRESS MAIL

I hereby certify that this document and the documents referred to as enclosed therein are being deposited with the U. S. Postal Service in an envelope as "Express Mail Post Office to Addressee" addressed to: Commissioner of Patents, Mail Stop Appeal Brief - Patents, P. O. Box 1450, Alexandria, VA 22313-1450, prior to 5:00 p.m. on 9 day of March, 2004.

Andrew Tipton
Andrew L. Tipton
Express Mail Label #EL 974184297 US

The Examiners admit that Arnold does not teach that 6-[2-(1(2)H-tetrazole-5-yl)ethyl]decahydroisoquinoline-3-carboxylic acid can be used as an anesthetic (as opposed to an analgesic). However, the Examiner proceeds to argue that the compound functions as an anesthetic, inadvertently, when used for other purposes, as in Arnold. This is simply incorrect. The compound is not a local anesthetic, yet it is a spinal anesthetic (specification, p. 3, lines 12-15). This makes the use of the compound as defined in the claims novel. There is no mention of intrathecal administration in Arnold. The methods of administration in Arnold are oral, rectal, transdermal, subcutaneous, intravenous, intramuscular or intranasal (Arnold, col. 35, lines 30-32). As explained, based on the evidence of record, analgesics do not function as anesthetics when normally administered (see Hug, C.C., Jr., *Does Opioid "Anesthesia" Exist?* Anesthesiology, 73 (1990) 1-4). Since with none of these methods of administration does the compound act as an anesthetic or a spinal anesthetic, the rejection must fail. Therefore, there is no reason to believe that the compound would function as an anesthetic, inadvertently, when used for other purposes, and when differently administered as in Arnold. The compound is not a local anesthetic. Besides the current compound, only local anesthetics produce spinal anesthesia when injected into the fluid surrounding the spinal cord. Therefore, it is not obvious it will produce spinal anesthesia when injected intrathecally. Why inject the compound intrathecally when it is not even a local anesthetic? It is certainly not obvious to do so. And the art makes no *prima facia* case.

There is a typographical error on p. 3 of the appeal brief. It should read: "The amount used to provide the desired spinal anesthetic effect will vary generally within the range of 0.1

mcg/kg to 60 mcg/kg of body weight, preferably from 5 mcg/kg to 40 mcg/kg of body weight."

II. Conclusion

For the above-stated reasons, and for the reasons set forth in Appellants' appeal brief and reply brief, Appellant respectfully requests reversal of the decision of the Examiner, and allowance of the application.

It is not believed a fee is due with this brief. If a fee is due, please consider this a request to debit or credit Deposit Account No. 26-0084 accordingly.

Respectfully submitted,

Andrew Tipton

ANDREW L. TIPTON, Reg. No. 54,492
McKEE, VOORHEES, & SEASE
Attorneys of Record

801 Grand - Suite 3200
Des Moines, Iowa 50309-2721
Phone: 515-288-3667
CUSTOMER NO. 22885

- alt/bja -